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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/823,032
Filing Date: April 13, 2004
Appellant(s): KUMMER ET AL.

Brian A. Lemm
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 22, 2008 appealing from the Office action mailed December 31 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0133471	Eskandari et al	9-2002
6,477,243	Choksi et al	11-2002

2003/0101148	Montgomery et al	5-2003
2002/0176111	Shaw et al	11-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Eskandari et al., U.S. Publication No. 2002/0133471.

As per claims 1 and 8, Eskandari discloses a method and system for a mailing machine to change operational features comprising: establishing a communication link with a remote data center via a network (Eskandari: Figure 1; paragraph 0066, "remote location via a computer network such as the internet" – The Examiner interprets the system device used to enter the authorization code 14 at the remote location to be a remote data center.); receiving from the remote data center, via the communication link, a directory file, the directory file including an indication of all operational features that should be enabled within the mailing machine (Eskandari: Figure 1, "14"; paragraphs 0019, 0031, 0034, 0042, 0053, 0059-0060, and 0066 – The Examiner interprets the authorization code 14 to be the directory file based on the definition of a "file" in the Microsoft Computer Dictionary. See reference U in the PTO-892 form.), each of the

operational features having at least one associated operating file required to implement the operational feature (Eskandari: paragraphs 0017-0018, 0045, and 0047-0048, "parameter set"); determining if an operating file stored in a memory of the mailing machine is not associated with an operational feature indicated in the directory file (Eskandari: Figure 1, "36"; paragraphs 0042 and 0062); and deleting any operating files stored in the memory of the mailing machine that are not associated with an operational feature indicated in the directory file (Eskandari: Figure 1, "36"; paragraphs 0031, 0042, and 0061-0062), wherein deletion of any operating file stored in the memory of the mailing machine that is not associated with an operational feature indicated in the directory file disables an operational feature with which the deleted operating file is associated (Eskandari: Figure 1, "36"; paragraphs 0031, 0042, and 0061-0062).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-5, 9, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandari et al., U.S. Publication No. 2002/0133471.

As per claims 2 and 9, Eskandari discloses the method and system of claims 1 and 8 as described above. Eskandari further discloses receiving from at least one operating file associated with a new operational feature to be enabled in the mailing

machine (Eskandari: paragraphs 0037, 0050 and 0066), the directory file including an indication of the new operational feature (Eskandari: paragraphs 0019, 0031, 0034, 0042, 0053, 0059-0062, and 0066); and storing the at least one operating file associated with the new operational feature in the memory of the mailing machine (Eskandari: paragraph 0062-0063). Eskandari does not disclose receiving from the remote data center at least one operating file. Eskandari discloses receiving information from a remote location (Eskandari: paragraph 0066).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and system of Eskandari to have included receiving from the remote data center at least one operating file as disclosed by Eskandari for the advantage of allowing an operator to control the mailing machine without being physically present at the machine.

As per claims 4 and 11, Eskandari discloses the method and system of claims 2 and 9 as described above. Eskandari further discloses activating the at least one operating file associated with the new operational feature, thereby enabling the new operational feature in the mailing machine (Eskandari: paragraphs 0042 – The Examiner interprets the step of the franking module enabling and disabling operating features to be the step of activating the at least one operating file associated with the new operational feature.).

As per claims 5 and 12, Eskandari discloses the method and system of claims 2 and 9 as described above. Eskandari further discloses updating an activation status stored in the memory of the mailing machine to correspond to the directory file

(Eskandari: paragraph 0062 – The Examiner notes, one of basic knowledge would recognize that information saved on a system can readily be stored in a table format in order to better organize the data. The applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein.).

Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandari et al., U.S. Publication No. 2002/0133471 in view of Choksi et al., U.S. Patent No. 6,477,243.

As per claims 3 and 10, Eskandari discloses the method and system of claims 2 and 9 as described above. Eskandari further discloses the receipt of the directory file and the at least one operating file associated with the new operational feature (Eskandari: paragraphs 0037, 0050, and 0066). Eskandari does not disclose sending confirmation of the receipt of information.

Choksi discloses sending confirmation of the receipt of information (Choksi: column 2, lines 18-23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and system of Eskandari to have included sending confirmation of the receipt of information as disclosed by Choksi for

the advantage of notifying a customer that the information required to perform a particular task has been received.

Claims 6, 13, 15-16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandari et al., U.S. Publication No. 2002/0133471 in view of Montgomery et al., U.S. Publication No. 2003/0101148.

As per claims 6 and 13, Eskandari discloses the method and system of claims 2 and 9 as described above. Eskandari further discloses processing the directory file and at least one operating file (Eskandari: paragraphs 0042 and 0062). Eskandari does not disclose signing a file with a digital signature and verifying the signature wherein if the digital signature does not verify, processing of the files are not performed.

Montgomery discloses verifying a digital signature and authenticating a postage indicium (processing of files) if the verification is successful (Montgomery: paragraph 0013).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and system of Eskandari to have included signing a file with a digital signature and verifying the signature wherein if the digital signature does not verify, processing of the files are not performed as disclosed by Montgomery for the advantage of verifying that the received files are from a trusted party (Eskandari: paragraphs 0012-0013).

As per claim 15, Eskandari discloses a mailing machine comprising: a network adapted to communicate with a remote data center via a network (Eskandari: paragraph

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0066, "remote location via a computer network"), the mailing machine adapted to receive from the data center a directory file associated with a new operational feature to be enabled in the mailing machine (Eskandari: paragraphs 0031, 0042 0066 – The Examiner interprets the authorization code 14 to be the directory file based on the definition of a "file" in the Microsoft Computer Dictionary. See reference U in the PTO-892 form.), the directory file including an indication of all operational features that should be enabled within the mailing machine (Eskandari: Figure 1, "14"; paragraphs 0019, 0031, 0034, 0042, 0053, 0059-0060, and 0066), each of the operational features having at least one associated operating file required to implement the operational feature (Eskandari: paragraphs 0017-0018, 0045, and 0047-0048, "parameter set"); a memory (Eskandari: paragraphs 0062-0063); a controller coupled to the network and memory (Eskandari: Figure 1, "36"), the controller adapted to determine if an operating file stored in the memory is not associated with an operational feature indicated in the directory file and delete any operating files stored in the memory that are not associated with an operational feature indicated in the directory file (Eskandari: Figure 1, "36"; paragraphs 0031, 0042, and 0061-0062), wherein deletion of any operating file stored in the memory of the mailing machine that is not associated with an operational feature indicated in the directory file disables an operational feature with which the deleted operating file is associated (Eskandari: Figure 1, "36"; paragraphs 0031, 0042, and 0061-0062).

Eskandari does not disclose a modem and receiving at least one operating file from the data center.

Eskandari discloses receiving information from the data center (Eskandari: paragraph 0066).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Eskandari to have included receiving at least one operating file from the data center as disclosed by Eskandari for the advantage of allowing an operator to control the mailing machine without being physically present at the machine.

Montgomery discloses a modem (Montgomery: paragraph 0089)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and system of Eskandari to have included a modem as disclosed by Montgomery for the advantage communicating information through a network.

As per claim 16, Eskandari in view of Montgomery discloses the mailing machine of claim 15 as described above. Eskandari further discloses the controller is further adapted to store the at least one operating file associated with the new operational feature in the memory and activate the at least one operating file associated with the new operational feature, thereby enabling the new operational feature in the mailing machine (Eskandari: paragraphs 0042 and 0062-0063 – The Examiner interprets the step of the franking module enabling and disabling operating features to be the step of activating the at least one operating file associated with the new operational feature.).

As per claim 18, Eskandari in view of Montgomery discloses the mailing machine of claim 15 as described above. Eskandari further discloses an activation status stored

in the memory, wherein the controller is further adapted to update the activation status to correspond to the directory file. (Eskandari: paragraph 0062 – The Examiner notes, one of basic knowledge would recognize that information saved on a system can readily be stored in a table format in order to better organize the data. The applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *in re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein.).

Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandari et al., U.S. Publication No. 2002/0133471 in view of Shaw et al., U.S. Publication No. 2002/0176111.

As per claims 7 and 14, Eskandari discloses the method and system of claims 1 and 8 as described above. Eskandari further discloses wherein operational features include accounting features, postal service features, type and capacity of external scales that can be utilized with the mailing machine, and data capture features (Eskandari: paragraphs 0040, 0043-0045, and 0047-0048). Eskandari does not disclose printing ad slogans and printing inscriptions.

Shaw discloses printing ad slogans and printing inscriptions (Shaw: Figure 2, “214”; paragraphs 0003 and 0005).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and system of Eskandari to have included printing ad slogans and printing inscriptions as disclosed by Shaw for the advantage of creating a mailpiece envelope that has more information.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandari et al., U.S. Publication No. 2002/0133471 in view of Montgomery et al., U.S. Publication No. 2003/0101148 and further in view of Choksi et al., U.S. Patent No. 6,477,243.

As per claim 17, Eskandari in view of Montgomery discloses the mailing machine of claim 15 as described above. Eskandari further discloses the receipt of the directory file and the at least one operating file associated with the new operational feature (Eskandari: paragraphs 0037, 0050, and 0066). Eskandari in view of Montgomery does not disclose wherein the controller is further adapted to send confirmation of the receipt of information utilizing a modem.

Choksi discloses sending confirmation of the receipt of a message (Choksi: Abstract and column 2, lines 18-23 – The Examiner notes, sending a confirmation message via e-mail suggests utilizing a modem.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Eskandari in view of Montgomery to have included wherein the controller is further adapted to send confirmation of the receipt of information utilizing a modem as disclosed by Choksi for the advantage of

notifying a customer that the information required to perform a particular task has been received.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eskandari et al., U.S. Publication No. 2002/0133471 in view of Montgomery et al., U.S. Publication No. 2003/0101148 and further in view of Shaw et al., U.S. Publication No. 2002/0176111.

As per claim 19, Eskandari in view of Montgomery discloses the mailing machine of claim 15 as described above. Eskandari further discloses wherein operational features include accounting features, postal service features, type and capacity of external scales that can be utilized with the mailing machine, and data capture features (Eskandari: paragraphs 0040, 0043-0045, and 0047-0048). Eskandari does not disclose printing ad slogans and printing inscriptions.

Shaw discloses printing ad slogans and printing inscriptions (Shaw: Figure 2, "214"; paragraphs 0003 and 0005).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Eskandari in view of Montgomery to have included printing ad slogans and printing inscriptions as disclosed by Shaw for the advantage of creating a mailpiece envelope that has more information.

(10) Response to Argument

With respect to claims 1 and 8, the appellant alleges that Eskandari et al does not teach or suggest "deleting any operating files stored in the memory of the mailing

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machine that are not associated with an operational feature indicated in the directory file." The Examiner respectfully disagrees. As present in the response to arguments of the Final Rejection filed December 31 2007, Eskandari et al indeed does disclose the deleting feature.

Eskandari et al disclose in the invention

"in another embodiment, a currently enabled operating features 32 can be selected to be disabled. **The independent parameter 470 representing the enabled operating feature 32 can be removed from the franking system's parameter set 458.** The secondary parameters 472 and dependent parameters 476 are selected based on the updated parameter set 458. The new authorization code 14 is generated based on the updated parameter set 458, and is entered into the franking system 11. The enabled operating feature 32 is then disabled, and unavailable for use in the franking system11." [0061]

"In a futher embodiment, the operating features 12 of the current franking system 11 can be saved. When an update is to be accomplished, new operating features 30 are added to the saved operating features, **and operating features to be removed 24 are removed from the saved operating features.**" [0062] (Emphasis added)

The Appellant points to paragraph [0035] of Eskandari et al and asserts that because Eskandari et al disclose that the franking system 11 can be upgraded or downgraded at any point in the distribution chain without providing additional hardware or software for the franking system then Eskandari et al cannot delete any operating files stored in the memory. The Examiner respectfully disagrees. Paragraph [0053] of Eskandari et al only describes one embodiment of the invention and cannot be taken as the limit of the invention, clearly in other embodiments such as in paragraphs [0061] and [0062] operating features are removed from the franking system. Eskandari et al is merely stating that providing additional hardware or software is not necessary, rather

than impossible. Eskandari et al even disclose that the listing of enabled operating features can be stored on a storage device such as a CD or floppy disk [0056] which certainly can be used to introduce new software to the franking system.

The Appellant further alleges that removing the parameter 470 from the parameter set 458 does not delete an operating file, that the parameter 470 is not the same as an operating file. The Examiner respectfully disagrees. Eskandari et al disclose that selected operating features are used to generate at least one independent parameter 470 representing the selected operating feature. [0046] Since the parameter represents the selected operating feature, by removing this parameter the franking system no longer sees the feature as operating and disables the feature [0061]. The claimed limitations must be given the broadest reasonable interpretation; the broadest reasonable interpretation of "operating files" as disclosed by the Appellant is files that must be present for the features to operate. When given the broadest reasonable interpretation, the parameter as disclosed by Eskandari et al serve the same purpose as the operating files disclosed by the Appellant, both must be present for the features to operate.

Therefore, Eskandari et al teach deleting any operating files stored in the memory of the mailing machine that are not associated with an operational feature indicated in the directory file.

For at least the above reasons, claims 1 and 8 stand rejected under Eskandari et al.

With respect to claim 2, claim 2 is rejected due to its dependency on a rejected claim. Further, the Appellant alleges that Eskandari et al does not teach or suggest receiving any operating files from a data center. The Examiner respectfully disagrees. As presented in the previous Final Office Action, Eskandari et al does not expressly disclose receiving from the remote data center at least one operating file. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and system of Eskandari et al to have included receiving from the remote data center at least one operating file as disclosed by Eskandari et al for the advantage of allowing an operator to control the mailing machine without being physically present at the machine. Furthermore, Eskandari et al disclose that selected secondary parameter 472 can be entered into a computer system or network, such as the internet, and stored in the parameter set 358, 458. [0050] and receiving information from a remote location [0060]. Therefore, Eskandari et al certainly has the ability to receive at least one operating file from a remote data center.

For at least the above reasons, claim 2 stand rejected.

With respect to claims 4 and 5, claims 4 and 5 are rejected due to its dependency on the rejected claim 1.

With respect to claim 9, claim 9 is rejected due to its dependency on a rejected claim. Further, the Appellant alleges that Eskandari et al does not teach or suggest receiving any operating files from a data center. The Examiner respectfully disagrees.

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As presented in the previous Final Office Action, Eskandari et al does not expressly disclose receiving from the remote data center at least one operating file. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method and system of Eskandari et al to have included receiving from the remote data center at least one operating file as disclosed by Eskandari et al for the advantage of allowing an operator to control the mailing machine without being physically present at the machine. Furthermore, Eskandari et al disclose that selected secondary parameter 472 can be entered into a computer system or network, such as the internet, and stored in the parameter set 358, 458. [0050] and receiving information from a remote location [0060]. Therefore, Eskandari et al certainly has the ability to receive at least one operating file from a remote data center.

For at least the above reasons, claim 9 stand rejected.

With respect to claims 11 and 12, claims 11 and 12 are rejected due to its dependency on the rejected claim 8.

With respect to claims 3 and 10, claims 3 and 10 are rejected due to obviousness over Eskandari et al in view of Choksi et al.

With respect to claims 6 and 13, claims 6 and 13 are rejected due to obviousness over Eskandari et al in view of Montgomery et al.

With respect to claim 15, the appellant alleges that Eskandari et al does not teach or suggest "deleting any operating files stored in the memory of the mailing machine that are not associated with an operational feature indicated in the directory file." The Examiner respectfully disagrees. As present in the response to arguments of the Final Rejection filed December 31 2007, Eskandari et al indeed does disclose the deleting feature.

Eskandari et al disclose in the invention

"in another embodiment, a currently enabled operating features 32 can be selected to be disabled. **The independent parameter 470 representing the enabled operating feature 32 can be removed from the franking system's parameter set 458.** The secondary parameters 472 and dependent parameters 476 are selected based on the updated parameter set 458. The new authorization code 14 is generated based on the updated parameter set 458, and is entered into the franking system 11. The enabled operating feature 32 is then disabled, and unavailable for use in the franking system11." [0061]

"In a further embodiment, the operating features 12 of the current franking system 11 can be saved. When an update is to be accomplished, new operating features 30 are added to the saved operating features, **and operating features to be removed 24 are removed from the saved operating features.**" [0062] (Emphasis added)

The Appellant points to paragraph [0035] of Eskandari et al and asserts that because Eskandari et al disclose that the franking system 11 can be upgraded or downgraded at any point in the distribution chain without providing additional hardware or software for the franking system then Eskandari et al cannot delete any operating files stored in the memory. The Examiner respectfully disagrees. Paragraph [0053] of Eskandari et al only describes one embodiment of the invention and cannot be taken as the limit of the invention, clearly in other embodiments such as in paragraphs [0061] and

[0062] operating features are removed from the franking system. Eskandari et al is merely stating that providing additional hardware or software is not necessary, rather than impossible. Eskandari et al even disclose that the listing of enabled operating features can be stored on a storage device such as a CD or floppy disk [0056] which certainly can be used to introduce new software to the franking system.

The Appellant further alleges that removing the parameter 470 from the parameter set 458 does not delete an operating file, that the parameter 470 is not the same as an operating file. The Examiner respectfully disagrees. Eskandari et al disclose that selected operating features are used to generate at least one independent parameter 470 representing the selected operating feature. [0046] Since the parameter represents the selected operating feature, by removing this parameter the franking system no longer sees the feature as operating and disable the feature [0061]. The claimed limitations must be given the broadest reasonable interpretation; the broadest reasonable interpretation of "operating files" as disclosed by the Appellant is files that must be present for the features to operate. When given the broadest reasonable interpretation, the parameter as disclosed by Eskandari et al serve the same purpose as the operating files disclosed by the Appellant, both must be present for the features to operate.

Therefore, Eskandari et al teach deleting any operating files stored in the memory of the mailing machine that are not associated with an operational feature indicated in the directory file.

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For at least the above reasons, claim 15 stand rejected due to obviousness over Eskandari et al in view of Montgomery et al

With respect to claims 16 and 18, claims 16 and 18 are rejected due to its dependency on the rejected claim 15.

With respect to claims 7 and 14, claims 7 and 14 are rejected due to obviousness over Eskandari et al in view of Shaw et al.

With respect to claims 17 and 19, claims 17 and 19 are rejected due to its dependency on the rejected claim 15.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Rob Wu

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Examiner, Art Unit 3628

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John Hayes – SPE, 3628
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